

07-2804

AF/IDW  
3629  
\$



## In the United States Patent and Trademark Office

Appn. Number: 09/832,440

Appn. Filed: 2001 April 11

Applicant: Steve Morsa

Examiner/ GAU: Jonathan Ouellette/3629

Title: Method and Apparatus for the Furnishing of  
a Variety of Benefits Information and Benefits

Thousand Oaks, CA 2004 July 26, 2004

Mail Stop AF  
Commissioner for Patents  
POB 1450  
Alexandria, VA 22313-1450

### Amendment C (On Appeal)

*Applicant/Appellant respectfully submits the following:*

In order to present the claims under appeal in better form for consideration; per Rule 116, the following claims only have had non-substantive changes made to them; specifically, as can be seen, consisting merely of the removal of parenthesis and quotation marks:  
Claims 16, 69, 70, 153, 154, 168 only.

All other claims, per Amendment B (After Final), remain the same.

16. (currently amended) The system of claim 1, further comprising means for displaying a plurality of available benefits applicable to said data, said plurality of available benefits listed in a manner selected from the group consisting of benefit class or category, value of benefits, cost ☐if any☐ of benefits, importance of benefits, relevance of benefits, ease of use of benefits, expiration ☐date☐ of benefits, creation ☐date☐ of benefits, type of benefits, and physical proximity of said entity to one or more said benefit providers.

69. (currently amended) The system of claim 1, wherein said entity may at entity's option input a complete set of ☐phantom☐ data; wherein said ☐phantom☐ data does not belong to nor correspond to said entity's actual factual data.

70. (currently amended) The system of claim 1, wherein said entity may at entity's option input a partial set of [""phantom[""] data; wherein said partial set of phantom data does not belong to nor correspond to said entity's actual factual data; said phantom data being inputted together and concurrently with some partial set of actual factual data of said entity.

101. (currently amended) The method of claim 87, further comprising the step of displaying a plurality of available benefits applicable to said data, said display listing benefits in a manner selected from the group consisting of benefit class or category, value of benefits, cost [""if any[""] of benefits, importance or benefits, relevance or benefits, ease of use of benefits, expiration [""date[""] of benefits, creation [""date[""] of benefits, type of benefits, and physical proximity of said entity to one or more of said benefit providers.

153. (currently amended) The method of claim 87, further comprising the step, at said entity's option, of inputting a complete set of [""phantom[""] data; wherein said [""phantom[""] data does not belong to nor correspond to said entity's actual factual data.

154. (currently amended) The method of claim 87, further comprising the step, at said entity's option, of inputting a partial set of [""phantom[""] data; wherein said partial set of phantom data does not belong to nor correspond to said entity's actual factual data; said phantom data being inputted together and concurrently with some partial set of actual factual data of said entity.

**Certificate of Faxing:** I hereby certify that I will Fax this paper to GAU 3629 of the U.S. Patent and Trademark Office at 703-872-9306 on the date below:

Date: July 26, 2004



Steve Morsa, Applicant

Amendment C; page 2 of 2



## In the United States Patent and Trademark Office

Re Application of Steve Morsa

Ser. No. 09/832,440

Filed 2001 April 11

For: Method and Apparatus for the Furnishing of a  
Variety of Benefits Information and Benefits

Examiner Jonathan Ouellette

Art Group 3629

July 27<sup>th</sup> 2004

### Notice

Because the PTO Auto-Reply Fax Transmission I received yesterday indicates that one or more pages of the papers which were Faxed to the PTO [ to: (703) 872-9306 ] on July 26<sup>th</sup> 2004 may not have been received (the connection was lost/interrupted several times during transmission); in order to insure the accurate, complete, and timely receipt by the PTO of all the papers; please find in this mailing what was Faxed that day (as listed in Express Mailing certification, below). The Faxed Credit Card Payment form (PTO-2038) has been included herewith to insure THAT wasn't the/one of the pages which didn't "go through." Obviously, please do not charge my credit card another \$220 payment [Brief (\$165) plus Time Extension (\$55) ] if it's already been done, Thank you for your help.

### Express Mailing Certification

I hereby certify that this correspondence is being deposited with the United States Postal Service via Express Mail in an appropriate envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 07/27/2004.

Express Mail Label Number: ED001426320US

Papers included herewith are: Appeal Brief with Exhibit (62 pages), Amendment C (2 pages), Transmittal Form (1 page), Petition for Extension of Time (1 page), Credit Card Payment Form (1 page), and Fee Transmittal (1 page).

Steve Morsa

Steve Morsa

# In the United States Patent and Trademark Office

In Re Application of: Steve Morsa

Ser. No: 09/832,440

Filed: 2001 April 11

For: Method and Apparatus for the Furnishing of a  
Variety of Benefits Information and Benefits

Examiner: Jonathan Ouellette

Group Art: 3629

Mail Stop AF

Commissioner For Patents

P.O. Box 1450

Alexandria, VA 22313-1450

## Appeal Brief

*62 pages in total; inclusive of Exhibit and Appendix*

(1) **Real Party in Interest:** Applicant/Appellant; Steve Morsa.

(2) **Related Appeals and Interferences:** None.

(3) **Status of Claims:** The application was originally filed with claims 1-180. Claims 2-15, 25, 28-29, 31-45, 53, 56-57, 63, 75-79, 88-100, 110, 113-114, 116-130, 137, 140-141, 147, 159-163, 165, 168, 170, and 172 have been cancelled.

Claims 1, 16-24, 26-27, 30, 46-52, 54-55, 58-62, 64-74, **80, 81, 82**, 83-86, **87**, 101-109, 111-112, 115, 131-136, 138-139, 142-146, 148-158, **164**, 166-167, **169**, 171, 173-175, **176**, 177-180 remain in the case and are the subject of this appeal (independent claims in bold). The claims on appeal are in the Appendix.

07/30/2004 #ABDELRI 00000080 09832440

02 FC:2402

165.00 OP



**(4) Status of Amendments:** A response was filed March 20<sup>th</sup>, 2004 (Amendment B) to the Final Rejection but it did not involve amendment to the specification or the claims. Amendment C was filed July 26<sup>th</sup>, 2004 in order to present claims 16, 69, 70, 153, 154, 168 only in better form for consideration (per Rule 116); which changes were of a non-substantive nature; specifically, consisting merely of the removal of parenthesis and quotation marks.

**(5) Summary of the Invention:**

The present invention is designed to provide an entity with real-time benefit information, from a variety of benefit providers, in a format that is understandable and informative. The system is unique in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time; presenting these results to the user in one organized presentation.

The system is a sophisticated computerized system by which gathered benefit information from a plurality of benefit providers may be electronically connected to a computer network. Value-added software is provided at the network to assimilate the data collected from various and multiple benefit providers in substantially real time, to place the data in an understandable format for preferably a single presentation to the benefit-seeking entity. The entity receives the assimilated data from the various and multiple benefit providers through an electronic connection (via modems) between the entity's computer and the network. A program on the entity's computer can capture the formatted data supplied by the network and prepare it for display or analysis. In an alternate configuration the benefit providers are electronically connected to a regional host. The regional host is then electronically connected to the computer network.

The system has many advantages over known benefit acquisition methods.

First, the system offers a "real time" picture of available benefits from multiple and varied benefit providers. Second, it allows the display in "real time" of only those benefits for which an entity is (or appears to be) qualified to receive.

Third, the system allows benefit providers to reduce or eliminate the often substantial costs of bringing their benefits to the attention of those entities qualified to receive them.

Fourth, the system provides the capability to an entity of acquiring various benefit providers' benefit information, the benefit-provider contact information, and the actual benefits themselves; all in one understandable and usable format that is currently not available via other methods.

A system and method are also disclosed for allowing an entity to discover what benefits said entity would be qualified to receive if entity data contained one or more inaccurate, "phantom" data factors, e.g., an incorrect current entity location; which could help entity to decide whether or not to relocate to a new city, state, area, country, etc.; entity's decision of whether or not to move then wisely based at least in part on the benefits available to entity at the contemplated new location.

#### **EXAMPLE**

An example of the present invention (taken here from the invention's specification) in use for a given entity will help better explain the unique aspects of the invention. In this brief scenario, the entity is an individual named "Dawn," an Internet surfer who has recently signed on the service provided in accordance with the present invention and who now is seeking to find out what benefits she is entitled to receive. Dawn logs her computer onto the network host utilizing interface management software provided by the network host (or dials into system via her telephone). Dawn then completes a personal profile questionnaire asking her for demographic, psychographic, geographic, and preference data. These may include such questions as Dawn's city or zip code, her income, marital/familial status, education, housing (renter, owner); type of housing: apartment, single-family home, co-op, townhome; birth date, nationality, occupation, any medical conditions or health needs, etc.; as well as her personal hopes, dreams, and interests/preferences.

Upon her submission of this profile (e.g., by “clicking” on the indicated “submit request” or similar icon; or via telephone by speaking with a live “operator,” or via an interactive voice response unit [IVRU]), etc., the interface formats these parameters and transmits her request for benefits to the network host. The network host, through network software, accesses the network database(s); which is (are) updated in substantially real time with previously gathered benefit information concerning various benefits available from various benefit providers. The network host then processes the information into a usable protocol that enables the entity interface management software to provide the data to Dawn in an appropriate presentation. Dawn’s computer (or telephone, FAX machine, etc.) then receives the processed information from the network host and displays the benefit information for her in real time.

For example, the benefits she qualifies for could include a zero-down payment, first-time home-buyer program offered by her city or state (helpful since she’s tired of renting and is getting married soon), printing off the loan application and accompanying city certificate for her probable use; a possible job with the city fire department (could be an interesting career); an SBA micro-loan program for women entrepreneurs (maybe starting her own business is the way to go); an internship at the local college (in case she wants to further her education), the in-depth details of which she carefully reviews on her computer screen; a promising new treatment for Alzheimer’s disease (good news for her elderly father), information about which she e-mail forwards to her dad; notice of an upcoming customs sale (Dawn’s heard there’s some real money to be made reselling that stuff); a great deal at the local music store on a new piano (she’s always wanted to take lessons); a federally-sponsored program that buys up old “clunker” cars to reduce air pollution (her smog-belching car is on its last legs); a reduced-rate, new-car loan program available from the local car dealership for recent college grads (she’ll have to replace her clunker somehow), details about which she stores to a floppy disk; federal prescription program for the infirm (something her aunt could really use); a local program to help working single moms afford quality daycare for their kids (the kind of program her sister really needs), the state voucher for which she prints off and gives to her sister; notice of next month’s upcoming county tax-defaulted real estate sale (to go along with her zero

down home loan), which list of properties Dawn stores to her hard drive; and a “two-for-one” ticket sale at the local opera (could be just the incentive needed to get Dawn’s fiancée to at least give opera a chance), the coupon for which she prints off to take with her to the opera house.

Optionally, Dawn may request real time updates of the benefit information via such means as e-mail, FAX, pager, hard-line or web-enabled phone, PDA (Personal Digital Assistants such as the Palm®), etc. Then, the benefit information applicable to her will be automatically updated as the information gathered from the benefit providers is updated. Such updates may also occur as, for example, due to the passage of time as when Dawn reaches various ages; since a number of benefits are generally known to be at least partially age-based. In addition, Dawn’s profile may be adjusted and updated from time to time by Dawn and/or the system operator. The result is that Dawn has real time or near real time access in a readily understandable format, on a single display screen (or other single “benefit touch point”) of all the benefits for which she is qualified to receive. Regardless of the source(s) of those benefit(s).

Given the numerous wide and varied arguments in support of the system; along with the desire to avoid needless repetition and for ease of review and consideration of the issues at hand, a concise and detailed explanation and treatment of the subject invention follows in “(8) Argument.”

**(6) Issues:**

A) Are Claims 1, 16-24, 26-27, 30, 46-52, 54-55, 58-62, 64-74, 80-87, 101-109, 111-112, 115, 131-136, 138-139, 142-146, 148-158, 164, 166-167, 169, 171, and 173-180 patentable under 35 U.S.C.103 (a) over College Board ([www.collegeboard.com](http://www.collegeboard.com), screen print, 1/25/1999) in view of Baker, III (US 6,266,648).



**(7) Grouping of Claims:**

For purposes of this appeal, the claims should be grouped as follows:

- A) 1, 16-24, 26-27, 30, 46-52, 54-55, 58-62, 64-74, 83-87, 101-109, 111-112, 115, 131-136, 138-139, 142-146, 148-158, 177-180. These claims do not stand or fall together.
- B) 80, 81, 82. These claims stand or fall together.
- C) 164-168. These claims do not stand or fall together.
- D) 169-175. These claims do not stand or fall together.
- E) 176. This claim stands or falls on its own.

**(8) Argument:****The References and Differences of the Present Invention Thereover**

Prior to discussing the claims, applicant will first discuss the invention, the references, and the general novelty of the present invention and its unobviousness over the references.

Applicant's ground-breaking invention teaches how to *anonymously* match an up-to unlimited number of (including little-known and hard-to-find) government and non-government benefits and benefit information within and throughout all benefit classes/categories *directly* to entities of all types—individuals as well as companies/businesses, educational institutions, governments, etc; doing so with *no required advance knowledge or understanding* of these benefits by the benefit-seeking entity. The system does this using *only* the demographic, geographic, psychographic, and preference information of the entity itself to identify and locate the benefits (being offered by the now *far more efficient and effective* benefit providers themselves). Which makes the present system a novel and unobvious method and system the likes of which has never been known before.

**College Board** ([www.collegeboard.com](http://www.collegeboard.com), Screen Print, 1/25/1999) is a system/method for the express and limited single purpose of matching individuals only with “ . . . *scholarships, loans, internships, and other financial aid programs from non-college sources . . .*” (from page 2 of the 1/25/1999 screen print reference). Note also the even further negatively recited limitation of the College Board’s educational class/category of benefits as being required to be only from “ . . . *non-college sources . . .*”(screen print, p.2). In fact, the next sentence goes on to clarify what their system/method *really is* and what individuals *actually* received when they used their system/method, namely (and only) “ . . . *potential scholarship opportunities . . .*” Note also in the following paragraph that College Board’s system/method is called (appropriate given its stated purpose) “*Scholarship Search;*” and that Scholarship Search’s information is derived from “*The Scholarship Handbook.*” Demonstrating that College Board/Scholarship Search is a *limited* benefit-matching system.

Applicant’s method/system (as is clear from its specification), on the **other** hand, is novel and different from College Board by having no such limits in either the classes/categories or the types of benefits which may optionally be made available; and does so not just for individuals, but *entities of all types*—including businesses, non-profits, educational institutions, and cities & states. One has only to visit the infringing GovBenefits.com and BenefitsCheckUp.org (BCU) sites to fully appreciate the functional differences between them/the present system and the College Board/Scholarship Search system.

As would be clear given both its stated purpose and actual operation; College Board does not teach any more than how to match *educational* class/category *non-college* aid with *individuals* seeking such *educational* class/category aid. Neither College Board nor any other company, individual, or organization had the foresight to provide such a scholarship-matching business method; limited in its use and value relative to the present system though it would be. Even such a system would not anticipate nor make obvious the present invention.

**Baker, III** (US 6,266,648) is—by its own description/specification—a method/system of aggregating “third-party enabling organizations” (credit card companies, professional associations, etc) in order to simplify the identification of (primarily) travel/vacation related benefits offered only by/through these enabling organizations; such benefits being available only to people having affiliations/memberships with these enabling organizations.

There are three critically important differences of the present system over Baker:

First, because this information in neither gathered nor correlated directly to the benefits themselves, Baker is unable to identify any benefits which the system user would qualify for based on user’s demographic, geographic, or psychographic information. Baker requires only that the user input user identification information to verify enabling organization association plus user’s purchase plan/interest(s)/preference data (abstract; Column 3 Line 2-3, L23-24, L29, L33-35; C4 L16-19; C5 L10-13; C7 L36-45, L50-55).

Yet, this is one of the prime purposes (and huge advantages) of the present system —that is, to enable people/entities to—*quickly, easily, and automatically*--discover the up to 100s to 1,000s of *often unknown* benefits they (may) already qualify for without having to know what they’re looking for. [See also # 99, page 20 of first OA, examiner’s admittance that “*Baker discloses a computer system that can correlate benefits between consumers and one or more enabling organizations . . .*” (and therefore not directly between consumers/entities and the benefit providers and benefits themselves) ].

With Baker, one has to know what one wants in order to get it. With the present system, one never does. This is a valuable and important difference.

Second, Baker requires an association with one or more benefit “providing” enabling organizations in order to receive any benefits; therefore receiving only those benefits available from such enabling organizations (abstract, C1 L16-19; C3 L17-19, L25-27, L44-45 and elsewhere). *Not so with the present invention.*

With Baker, one must be a “member” to get—*only*-- “member” benefits. With the present system, one doesn’t have to be a “member” of anything to get one’s benefits . . . and one doesn’t have to settle for just those benefits offered by enabling organizations, either.

Third, because it’s understandably needed to verify “affiliation” with the enabling organization(s), Baker requires some type of user identification in order to use the system (abstract, C2 L51-53; C3 L22-23, C6 L4-8, and elsewhere). The problem is that the user’s anonymity is then sacrificed; every time they attempt to see if the benefits they want are available to them—whether or not they even exercise their right to use them. Such loss of privacy is a major, growing problem in today’s society. With Baker, they know who one is (one’s name), what one wants, when one wants it, and how much one is willing to pay for it. With the present system (optimally/optionally), because one gets the benefit information/benefits confidentially--*they know nothing*.

Thus the present system has great and substantial differences over Baker. The clearly novel and unobvious present system is of far greater use, utility, and value (certainly by at least a factor of 5-10) than Baker. Applicant’s system is a benefit-matching method and system clearly unlike any that came before.

### **College Board and Baker Do Not Contain Any Justification to Support Their Combination, Much Less in the Manner Proposed**

The prior-art references do not contain any suggestion--express or implied—that they be combined, nor that they be combined in the manner suggested; nor that there would be a reasonable expectation of success. With regard to the proposed combination of College Board and Baker, it is well known that in order for any prior-art references themselves to be validly combined for use in a prior-art 103 rejection, *the references themselves* (or some other prior art) must suggest that they be combined, e.g., as was stated In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983):

“[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.”

That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (CAFC 1983):

“It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO].”

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988):

“[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself . . . *Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*” [Emphasis supplied.]

In line with these decisions, the Board stated in Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A. & I. 1993):

“In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. . . . That which is within the capabilities of one skilled in the art is not synonymous with obviousness. . . . That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention. . . . Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that ‘would lead’ that individual ‘to combine the relevant teachings of the references.’ . . . Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant’s invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.” [Emphasis supplied.]

In the present case, there is no reason given by the Examiner to support the proposed combination, other than the nearly identical statements, “Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included . . . *means for inputting into said system benefit information from two or more distinctly different benefit classes/categories*” (Page 4, # 10 of OA/Final); “. . . *wherein the benefits are from at least two distinctly different benefit classes/categories . . .*” (Page 12, # 58; Page 13, # 62; Page 16, # 79 ); “. . . *wherein the benefits contain at least two distinctly different benefit classes/categories . . .*” (Page 15, # 70).

However, the fact that both references teach some aspects of “benefit matching” is not sufficient to gratuitously and selectively substitute one or more parts of one reference (Baker’s multiple benefit classes/categories) for one or more parts of another reference in an attempt to meet applicant’s novel claimed system. It is well known that a basic mandate inherent in 35 U.S.C. 103 is that piecemeal reconstruction of prior art patents in light of the appellant’s disclosure shall not be the basis for a conclusion of obviousness.

The Examiner’s perceived motivation to combine the references—“. . . *to increase system effectiveness/customer service . . .*” (p. 4, #10, etc of OA)—is no more than mere unsupported statement and speculation; and therefore clearly not evidence; as is legally and properly required. It is well established that broad conclusory statements such as these regarding the obviousness of modifying or combining references are not evidence. There must be a reasoned basis to support such a conclusion of obviousness. Indeed, since a large percentage of all the millions of patents—and especially so those within the 705 classification—involve increasing some system’s (or product, process, etc. where applicable) effectiveness and/or customer service; were such statements/reasoning to be treated as evidence, precious few would survive. In fact, don’t most (all?) Class 705 patents increase some already-existing method/system’s effectiveness/customer service? Isn’t that why these inventions even exist?

Are not the largest share of patents improvement patents; where *effectiveness* or (especially in the case of systems/methods) *customer service* is increased?

The fact is, there is neither an express nor an implied teaching or suggestion in College Board or Baker (or any other prior art); whether considered individually or collectively, which would have motivated the artisan to combine the applied references in the manner urged by the examiner so as to result in the method/system defined by the claims at bar. Absent any such suggestion, one can only conclude that the Examiner's proposed combination of College Board's benefit matching system with Baker's multiple benefit classes/categories was based upon a hindsight reconstruction of the appellant's invention from the elements of the prior art.

As stated in Levengood,

"That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention."

As is well known, the Federal Circuit has produced a number of other decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.

### **Individually-Complete References Proves that the Combination of the References is Not Justified**

Each reference is complete and functional in itself, so there would be no reason to use parts from or add or substitute parts to either reference. College Board has been a complete, functioning/operating service for some years now; and while there appears to be no known "real world" application of/utilizing Baker; as its detailed specification including its drawings demonstrate; it, like College Board, is also complete and functional in and by itself.

There are, therefore, no reasons to use parts from, or add or substitute parts to, either reference. That they are each individually complete demonstrates and proves that the combination of the references is not justified.

### **Different-Field References Proves that the Combination of the References is Not Justified**

The references are from very different technical fields from each other. Despite the widespread use of the term “benefit(s)” during the prosecution of this application, a close inspection reveals that the two references themselves are in fact from very different and unrelated technical fields. Specifically, College Board is—by its own description and actual operation--a limited-purpose method/system for the identification only of non-college scholarships/educational financial aid. Baker, on the other hand, is—by its own description/specification--a method/system of aggregating enabling organizations in order to simplify the identification of primarily travel/vacation related benefits offered only by/through these enabling organizations; and only to people having affiliations with these enabling organizations. Therefore, because locating non-college educational financial aid for consumers (College Board) and aggregating enabling “membership” organizations (Baker) are most certainly unrelated to each other--*and therefore nonanalogous art*—there is no justification for the combination of these references.

### **The Proposed Modification Cannot Render the Prior Art Unsatisfactory for Its Intended Purpose--MPEP 2143.01**

*If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).*

Specifically, as stated, College Board is negatively and self-limited (negatively recited) **only** to the identification of and locating of *non-college* educational financial aid (for individuals) (p.2 of screen reference). Combining then Baker’s *variety* of benefits (if it were legal and proper to do so) with College Board would, because up to all benefits (in up to all classes/categories for individuals) would now be available (for individuals),



actually *cripple the purpose for which the College Board service exists*. That is, such a combination system would no longer be able to *match individuals exclusively and solely with non-college educational financial aid*; as College Board says it must. Thus, while the benefits identified and matched could certainly still be included in a total “benefits found disclosure/display,” because the proposed modification would render the prior art (College Board) *unsatisfactory for its intended purpose*, under MPEP 2143.01, the combination of College Board with Baker is neither legal nor proper.

### **The Proposed Modification Cannot Change the Principle of Operation of a Reference --MPEP 2143.01**

*If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.* In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Specifically, as stated, College Board is negatively and self-limited (negatively recited) **only** to the identification of and locating of *non-college* educational financial aid (for individuals) (p.2 of screen reference). Combining then Baker’s *variety* of benefits (if it were legal and proper to do so) with College Board would, because up to all benefits (in up to all classes/categories for individuals) would now be available (for individuals), actually *change the manner in which the College Board service operates*. That is, College Board’s constricted and limited system could no longer operate by simply drawing its non-college educational aid information from its *The Scholarship Handbook* book database; but would instead now have to, as stated, develop, create, and implement an entirely new *unlimited* methodology and system capable of delivering an up to virtually unlimited number and benefit class/category variety of benefits. Thus, because its single-benefit-class system is clearly inadequate for such an endeavor; such a logistically challenging modification must by obvious inherent necessity *change the principle of operation of the prior art* (College Board) in order to work. Therefore, under MPEP 2143.01, the combination of College Board with Baker is neither legal nor proper.

Clearly then, there is no *prima facie* justification for combining the references as suggested, as required by MPEP 2142 and 2143.

Applicant therefore submits that combining College Board and Baker is not legally justified and is therefore improper. Thus, applicant submits that the rejection on these references is also improper and should be withdrawn.

Applicant respectfully requests, if the claims are again rejected upon any combination of references, that the Examiner include an explanation, in accordance with M.P.E.P. 706.02, Ex parte Clapp, 27 U.S.P.Q. 972 (P.O.B.A. 1985), and Ex parte Levengood, supra, a “factual basis (or *prima facie* case) to support examiner’s conclusion that it would have been obvious” to make such a combination.

**Misunderstood References.** The Baker and College Board references do not disclose what the examiner relies upon them as supposedly teaching:

Baker: The last OA states (page 4, # 9; p.12 # 57; p.13 # 61; p.15 # 69; p.16 # 78) that, “Baker discloses a method/system for permitting a consumer to more effectively make use of a variety of available benefits from a plurality of goods and service providers (abstract, C3 L5-51).” However, Baker’s abstract states “ . . . *wherein the benefits are offered specifically to those consumers having an association with one or more enabling organizations.*” and, “ . . . enabling organization information . . . ” etc.; plus C1 L16-19 (note “ . . . *only to those having* . . . ”); and in C3 L5-51 (in particular L17-19, “. . . *offered specifically to those consumers having an association with one or more enabling organizations.*” , L25-26, “ . . . *enabling organization information* . . . ” , L27, “. . . *enabling organization* . . . ” L44-45, “. . . *consumer’s membership in [the] one or more enabling organizations.*” ) [see # 99, page 20 of the first OA].

As is stated and made clear throughout Baker—in its title, its abstract, background, summary; throughout its specification, claims, and even in its drawings—these enabling organizations are not merely of a subsidiary nature but are in fact an integral part and critical, foundational element of the Baker invention.

Accordingly, what Baker more accurately discloses is this: A method/system for permitting a *verified identified consumer who is affiliated with one or more third-party enabling organizations* to more effectively make use of a variety of *consumer identified and selected, enabling organization sourced* benefits from a plurality of goods and service providers. [Emphasis supplied.]

Paper Patent: Note here also that because the Baker reference appears to be a “paper patent;” that is, it was never implemented or commercialized, it should by necessity therefore be construed narrowly.

College Board: The last OA states that applicant’s independent claims # 1 and 87 are what College Board discloses (p.3, # 7 of OA). However, (as seen above) this reference makes clear that its system/method is for the express and limited single purpose of matching *individuals only* with “ . . . *scholarships, loans, internships, and other financial aid programs from non-college sources . . .*” (from page 2 of the 1/25/1999 screen print reference). Note also the even further negatively recited limitation of the College Board’s educational class/category of benefits as being required to be only from “ . . . *non-college sources . . .*” (screen print, p.2). In fact, the next sentence of reference goes on to clarify what their system/method *really is* and what individuals *actually* received when they used their system/method, namely (and only) “ . . . *potential scholarship opportunities . . .*” Note also in the following paragraph that College Board’s system/method is called—appropriate given its stated purpose—“*Scholarship Search;*” and that Scholarship Search’s information is derived only from “*The Scholarship Handbook.*” Demonstrating that College Board/Scholarship Search is a *limited* benefit-matching system.

As would be clear given both its stated purpose and actual operation; were the College Board system/method to have been backed by a patent; such a patent would have taught no better than how to match *educational* class/category *non-college* financial aid with *individuals* seeking such educational class/category aid.

Therefore, what College Board more accurately discloses (addressing p.3 # 7 of last OA) is: A system/method for permitting an *individual* to more effectively make use of *non-college educational financial aid* (hereinafter “*financial aid*”) from a plurality of *financial aid* providers, wherein said *financial aid* is offered specifically to those *individuals* qualified/eligible to receive said *financial aid*, said system comprising: means for storing in a memory in the system *an individual's* information, *financial aid* provider information, and *financial aid* correlation information; means for inputting into said system a set of *an individual's* demographic, geographic, psychographic, and preference data for said *individual*; means for comparing said *individual's* data set to determine those *financial aid* providers, if any, which have *financial aid* said *individual* is qualified to utilize; means for analyzing said *financial aid* provider information and said *financial aid* correlation information to determine whether any *financial aid* providers are offering potentially applicable *financial aid* for said data and whether said data satisfies requirements for obtaining said potentially applicable *financial aid*; means for displaying a message to inform a system user of any available *financial aid* applicable to said data; wherein said *financial aid* is available to the *individual* as a result of *individual's* qualifying or being eligible for at least one *source of financial aid* available from at least one *financial aid* provider. [Emphasis supplied.]

Accordingly then, what College Board also discloses (addressing p.12, # 55 of last OA) is: A system comprising a memory device having embodied therein information relating to *non-college educational financial aid* (hereinafter “*financial aid*”); a processor in communication with said memory device, said processor configured to: create a *financial aid* listing for a specified *individual* with a specified set of demographic, geographic, psychographic, and preference data; make available said *financial aid* listing; examine a plurality of *financial aid* that is available to a plurality of *individuals*, said listing to determine which of said plurality of

*financial aid* having qualification parameters; select at least one of said *financial aid*; and provide notification of *financial aid* information to said *individual*, including the *financial aid* providers corresponding to said selected *financial aid*. [Emphasis supplied.]

Accordingly then, what College Board also discloses (addressing p.13, # 59 of last OA) is: A system comprising a memory device having embodied therein information relating to a plurality of *non-college educational financial aid* (hereinafter “*financial aid*”); a processor in communication with said memory device, said processor configured to: receive a *financial aid* listing for a specified *individual* with a specified set of demographic, geographic, psychographic, and preference data; provide said *financial aid* listing to an *individual*; receive an acceptance of said *financial aid* listing from said *individual*; transmit said acceptance to a *financial aid* information provider; and receive *financial aid* information selected by said *financial aid* information provider, including the *financial aid* providers corresponding to said selected *financial aid*. [Emphasis supplied.]

Accordingly then, what College Board also discloses (addressing p.14, # 67 of last OA) is: A method of using a computer to process a *non-college educational financial aid* (hereinafter “*financial aid*”) information request, comprising the steps of: creating a *financial aid* listing; outputting said *financial aid* listing via an electronic system; examining a plurality of *financial aid* which would fulfill the *financial aid* information request relating to said *financial aid* listing to determine which, if any, of said plurality of *financial aid* to select for said *financial aid* listing; selecting, when available, at least one of said plurality of *financial aid*; outputting notification of *financial aid* information corresponding to said selected *financial aid*; and accepting at least one of said *financial aid*. [Emphasis supplied.]

And finally then, what College Board also discloses (addressing p.16, #76 of last OA) is: A method comprising the steps of: viewing, using a computer, *non-college educational financial aid* (hereinafter “*financial aid*”) information; transmitting, using a computer, a

request to obtain at least one *financial aid* corresponding to said *financial aid* information; receiving a commitment for at least one *financial aid*; accepting said commitment for said at least one *financial aid*; and receiving said at least one *financial aid*. [Emphasis supplied.]

**Even if College Board and Baker Were to Be Combined in the Manner Proposed, the Proposed Combination Would Not Show All the Novel Features of the Present Invention**

However, even if the combination of College Board and Baker were legally justified; which applicant vehemently disputes; the claims of the present system would still have novel and unobvious features over the proposed combination. In other words, applicant's invention, as defined by its independent claims, comprises much more than merely substituting Baker's multiple benefit classes/categories for a single class/category.

Specifically, note that both references teach clearly and unequivocally that theirs are *for-individuals-only* method/systems (College Board: screen print p.1-2; Baker: abstract; drawings Fig. 1, 2, 5a, 5b; C1 L15, L39, L51-52, etc.). The present invention, on the other hand, teaches all entities of all types (as readily seen, for example, in claims 1 and 87), "... storing in a memory in the system entity information," "... a set of entity demographic," "... comparing said entity information ..." and, "... a plurality of entities," "... for said entity ..." [claim 80] ... and, "... for a specified entity ..." [claims 81 and 82]); and as also readily detailed, presented, and taught throughout the present invention's abstract, its specification, drawings, etc.

With over 8,000,000 ( 8 million ) businesses of all sizes in the US ... over 35,000 American non-profits and charities ... over 20,000 private and public educational institutions including colleges; high-, middle-, elementary-schools spread out across all 50 states ... along with many 1,000's of cities, towns, counties, and other municipalities . . . this difference and the corresponding lack of "all-entities" enablement between the two references and the applicant's invention is no small matter. The ability to quickly and

easily match the up to 1,000's of various and varied benefits designed for, targeted to, and available for each of these millions of *non-individual* entities is huge.

Neither College Board nor Baker (and therefore no possible combination of the two) teaches *even a single sentence* to this novel, unobvious, and profoundly-valuable “benefit matching for all entities” capability. It is taught **only** by the present system.

Additionally, as stated, College Board only matches individuals with non-college financial aid from one book; and Baker is only able to match individuals “affiliated” with third-party enabling organizations to benefits only offered by/made available from/through these third-party enabling organizations. Thus, an actual combination of the two references (were it legal and proper) would result in an odd method/system indeed. In fact, such a combined; awkward and constricted method/system would—due to each references’ respective elements and the connections between such elements--do no better than enable the matching of third-party enabling organization affiliates with non-college educational financial aid sourced only through such third-party enabling organizations.

So now, instead of scholarship money being identified and made available to (potentially) virtually anyone via College Board, a combination with Baker would result in a privacy-compromising system whereby such scholarship funds would now only be available to *affiliates of enabling organizations*. With College Board being actually and readily available for use by all for some years now, why would anyone even bother with such a nearly valueless combined method/system, were it to ever exist? There’d be no reason to. Demonstrating that College Board and Baker each provide *by themselves* more utility and usefulness than any attempted combination of the two references would.

Applicant’s system, on the other hand, is able to *anonymously* offer a plethora of virtually any and all government and non-government benefits/information within and throughout all benefit classes/categories *directly* to entities of all types—individuals as well as companies/businesses, educational institutions, governments, etc. [Note here that even if

the teachings of College Board and Baker were combined (were it legal to do so), such combination still would not provide the **all-entity** enablement of the present invention.]

Given then its superiority [as stated in *Example/Dawn*], applicant thus logically submits that the present invention clearly recites novel subject matter which distinguishes over any possible combination of College Board and Baker.

**The Novel Features of the Independent Claims Produce New and Unexpected Results and Hence are Unobvious and Patentable Over These References Under 35 USC 103**

Applicant also submits that the above quoted novel features of claims 1, 80, 81, 82, 87, 164, 169, and 176 are also unobvious and hence patentable under 103 since they produce new and unexpected results over College Board and Baker; or any combination thereof.

These new and unexpected results are the ability of the present system to--*for the first time in history*--provide a practical and economically feasible system for quickly, easily, automatically, and anonymously matching a wide range of benefit-seeking entities with a wide range of diverse benefits (regardless of number of or type of benefit classes/categories) made available from up to virtually any number of benefit providers.

The aggregation of so many varied benefits in one place at one time for the benefit of so many produces a compelling, synergistic, super-efficient “benefit-compounding” effect which produces disproportionate positive results for both the benefit-seeking entities and the benefit providers. Because it is able to help far more people—as well as millions and millions of other non-individual entities--far more often in far more ways than limited, constricted systems like the references; the new, unexpected, disproportionate, unsuggested, and surprising results provided by the present system are far and away superior to either College Board or Baker, or any possible combination thereof [illustrated well, as stated, in *Example/Dawn*].



The novel features of applicant's method/system which effect these differences are, as stated, clearly recited in independent claims 1, 80, 81, 82, 87, 164, 169, and 176.

Indeed, even Examiner readily admits (pages 4, 12, 13, 15, and 16 of final OA) that a combination of College Board and Baker would produce advantages (increased system effectiveness and customer service). Applicant submits that the fact that the combination (were it legally justified and proper) produces advantages militates in favor of *applicant* because it proves that the combination as envisioned by the examiner produces new and unexpected results and hence is unobvious.

In fact, one has only to visit the two very successful, infringing services of GovBenefits (GovBenefits.gov) and BenefitsCheckUp (BenefitsCheckUp.com) to see just some of the surprising, valuable effects of the present system's new and unexpected results in "real world" action. [see also Exhibit A; four pages]

As is well-established; even if Examiner had been able to demonstrate *prima facie* (which applicant vehemently disputes); these unexpected results by themselves would rebut such a *prima facie* case of obviousness.

### **Overwhelming Objective Evidence of Non-Obviousness Present**

The Federal Circuit has made it very clear that secondary considerations must be considered when they are present, as they most certainly are here; and are to be given equal weight to the primary considerations; namely the other three factors:

"Objective evidence of nonobviousness, i.e. 'indicia' of *Graham v. John Deere* may in a given case be entitled to more weight or less, depending on its nature and its relationship to the invention's merits; it may be the most pertinent, probative and revealing evidence available to aid in reaching a conclusion on the obvious/nonobvious issue. It should, when present always be considered as an integral part of the analysis." *W.L. Gore & Associates v. Garlock, Inc.* 721 F2d 1540, 1555; 220 USPQ 303, 314 (Fed. Cir. 1983), *cert denied*, 469 U.S. 851 (1984)

Because they are clear, excellent examples of two possible “forms” or “instantiations” of the present system in actual “real world” operation; evidentiary support for some of the following categories of Objective Evidence of Non-Obviousness is readily found in the hugely successful GovBenefits and BenefitsCheckUp online services. While complete copies of their respective websites could have readily been supplied with this appeal as additional exhibits, they have not been so due to the large number of pages (on the order of 30-40+) they would have added to this appeal; and because they are so readily visible and reviewable at their respective websites; GovBenefits.gov and BenefitsCheckUp.com. Applicant/appellant will supply these additional exhibits if desired by the Board.

### **Commercial Success Proves Nonobviousness Over the References**

Applicant has found two system/methods which infringe applicant’s claims and have quickly achieved dramatic nationwide success. As noted in applicant’s previously PTO reviewed-and-approved Petition to Make Special, BenefitsCheckUp [BCU] (benefitscheckup.org), launched in June of 2001 and run by the National Council On the Aging (NCOA); and GovBenefits (govbenefits.gov), launched in April of 2002 and run by the United States Department of Labor, are both—according to both media reports and at their respective web sites (ncoa.org in the case of BenefitsCheckUp)--already *each* processing 35,000+ (BCU) and 400,000+ (GovBenefits) system users *each and every* month. Their quick, phenomenal, little or no commercial advertising successes powerfully demonstrates and proves the value of the novel and unobvious features of the present invention over College Board, Baker, or any combination thereof. [Please see Exhibit A, four pages].

### **Solution of Long-Felt and Unsolved Need Proves Nonobviousness**

The present system solves a long-felt but unsolved need. As explained and detailed in the present invention’s specification—additionally backed by its copious collection of non-

patent prior art in the Invention Disclosure Statement--the need for a quick, easy, and accurate way to match benefit-seeking entities with the myriad of classes and types of benefits for which they qualify for has been a painful, unmet need for many, many years; stretching back in the U.S. even to the advent of government-provided social welfare programs in the 1930's. Applicant's invention now quickly, easily, and automatically solves this dilemma; something neither College Board, nor Baker, nor any combination of the two can accomplish. [Please see applicant's IDS]

### **Synergism Proves Nonobviousness Over the References**

The whole (that is—the results achieved by the present system) is greater than the sum of its parts (that is—the respective results of the individual references). In comparing the results achieved by the two references, we see that College Board provides *just* individuals with *only* non-college educational financial aid; while Baker provides *just* individuals with *only* those benefits sourced through any third-party enabling organizations they happen to belong to. The present system, on the other hand (as stated) anonymously provides up to a virtually *unlimited* number of benefits across *all* benefit classes to entities of *all* types—individuals and non-individuals alike. Even when taken in combination, the results achieved by College Board and Baker clearly and conspicuously in no way compare to the *volume of*, the *diversity of*, and *ease of accessibility to*; the results achieved by (as detailed throughout this appeal) the present system (even without the present system's novel and valuable “benefits for *non*-individuals” teaching). This powerful synergistic effect proves the present invention to be nonobvious over College Board, Baker, or any combination of the two.

### **Multiplicity of Steps Required Proves Nonobviousness Over the References**

The combination suggested requires a series of separate, awkward combinative steps that are too involved to be considered obvious. College Board teaches only the matching of individuals with 3400 non-college educational financial aid source programs; said programs taken only from *The Scholarship Handbook's* “programs database” (p.2 of

reference). In order to integrate and combine Baker's multiple benefit classes/categories (were it legal and proper to do so) with College Board would require at a bare minimum: #1—The identification and categorization of up to 10s of 1,000s (or more) of varied benefits across both numerous and different benefit classes being offered by a myriad of benefit providers and provider-types located virtually everywhere in America; #2—The integration and correlation of these many 1,000s of benefits and benefit providers into the system; #3—The constant updating (and database management) of both the benefits themselves and their qualification, use, and availability parameters. Thus, given the series of separate, awkward combinative steps involved in attempting to create such a combination, it's clear that neither College Board, nor Baker, nor any possible combination of the two could possibly render the present system obvious. Yes, the present system is a quicker, easier, and far better system than has ever existed before; but (as with the infringing GovBenefits and BenefitsCheckUp services), it requires a substantial amount of dedicated and continuous work and effort to make and keep it so. [And even then; as stated, because the resultant combination would (unlike the present system) operate *only* for individuals, it would *still* fail to teach all that the present system teaches.]

### **Competitive Recognition Proves Nonobviousness Over the References**

As noted above, the present system has been (unknowingly) copied by at least two different infringers—The U.S. Department of Labor and the National Council on the Aging (NCOA). Moreover, James Firman, the President of NCOA, has made a number of statements to the media and via their website (ncoa.org) indicating that BenefitsCheckUp was the first web-based service ever to offer a wide range of benefits to those who are (or may be) qualified to receive them (in NCOA's case, "senior" citizens). Also, laudatory statements are being made on a regular basis to the media by many US federal government office holders and officials praising the wonderful and hugely-popular, Dept. of Labor-run GovBenefits service. Demonstrating the present invention to be nonobvious over College Board, Baker, or any combination of the two.

### **Assumed Insolubility Proves Nonobviousness Over the References**

Looking now again to applicant's extensive collection of non-patent prior art in the IDS; up to now those skilled in the art thought or found the problems solved by the present system to be insoluble. That is, the present system converts the failure of others to come up with a quick, easy, and anonymous way to match benefit-seeking entities of *any* type *directly* with an up to unlimited number of--*and number of classes/categories of*--the benefits (and the benefit providers) themselves. These failures of prior-art workers (backed by many millions of dollars from the federal and various state governments) indicates that a solution to the nationally-endemic problem of matching the 100's--1,000's of available benefits with those who need and qualify for them most certainly was not obvious. As the IDS articles clearly show--no one knew what to do to solve this terrible problem. Which proves the present system to be nonobvious over College Board, Baker, or any combination of the two. [Please see IDS]

### **New Principle of Operation Proves Nonobviousness Over the References**

Instead of following a well-worn trail looking for incremental improvements in what already existed, the present system utilizes a new "*anonymous, unlimited* benefit class/category aggregation and dissemination" principle of operation to blaze an exciting new trail; creating a far more effective and useful benefit identification and matching system/method unlike anything that ever existed before (again, as readily seen in the GovBenefits and BCU services). Clearly something neither College Board, nor Baker, nor any combination thereof could ever teach or deliver.

### **References Teach Away Proves Nonobviousness Over the References**

By implication, College Board and Baker themselves teach away from the suggested combination. Specifically (as stated), College Board is negatively self-limited (negatively recited) only to the identification of and locating of non-college educational financial aid

(page 2 of the 1/25/1999 screen reference) derived exclusively from “*The Scholarship Handbook*.” Therefore, the sole purpose of the College Board method/system is to more easily match individuals with the non-college educational financial aid (sources) found in *The Scholarship Handbook*. So, while it certainly has value; College Board’s obviously very limited method/system basically only “saves” people from having to spend time going through a single book looking for educational funding which they may qualify for. It is a nice, little, narrowly-targeted, self-contained, insular service/system. Given this, then; because any attempted combination of the College Board system with Baker’s “match consumers with 3<sup>rd</sup> party enabling organizations” system would obviously destroy the self-stated and operationally sole purpose of College Board; College Board most certainly implicitly teaches against such a system-cripplingly combination. Indeed, it’s not why the excellent College Board organization itself even exists in the first place. It’s not what they do. It’s not what they’ve ever done. It’s not what they even want to do. They—and their system—help people looking for ways to better afford college. And that’s all. Accordingly, because it clearly then would not have been obvious to combine these two references, the present system is nonobvious over College Board, Baker, or any possible combination of the two.

### **Different Problem Solved Proves Nonobviousness Over the References**

Applicant’s system solves a different problem than the references; and such different problem is recited in the claims. *In re Wright*, 6 USPQ 2d 1959 (1988). Unlike College Board, which only helps solve the different, relatively small problem of locating non-college scholarships and the like for individuals; and Baker, which involves the also different, relatively small problem of improving the effectiveness of third-party enabling organizations, the present system helps solve the nationally endemic and far different problem of matching individuals (directly and [optionally] anonymously)—and optionally other types of entities as well—with up to a virtually unlimited number and variety of diverse class/category benefits being offered by a multitude of benefit providers.

Because the present system does therefore solve a different (and far larger and more important) problem than College Board, Baker, or any combination thereof, it is nonobvious.

### **Lack of Implementation Proves Nonobviousness Over the References**

If the present invention were in fact obvious, because of its many advantages, those skilled in the art surely would have implemented it long before the present system's 4/12/2000 PPA priority date. According to the two references, though the College Board method/system has existed in some form since the mid to late 1990's and Baker since June of 1996, it wasn't until the June, 2001 launch of the Benefits Check Up service by the NCOA that (an infringing form of) applicant's method/system was brought to the marketplace. That's over at least three years of time; which, given the explosive growth of Internet-based and other business method/systems during this time--*including 1,000s of business-method patent filings plus non-patented operating and proposed systems/methods*--clearly and unequivocally demonstrates and proves that the present system was neither anticipated by nor made obvious by College Board, Baker, or any combination of the two.

### **The Following Dependent Claims are A Fortiori Patentable Over College Board and Baker**

As demonstrated above, applicant submits that all of his independent claims define novel and unobvious subject matter over the references. All of the dependent claims incorporate all of the limitations of the independent claims and add additional limitations and subject matter and thus are a fortiori patentable. In addition; and especially so in view of the College Board and Baker references being misunderstood, as stated; the following dependent claims are also independently patentable for the following reasons:

Dependent claims 16 and 101 are independently patentable because they further recite various manners of displaying the available benefits; which is entirely foreign to College Board, Baker (hereinafter "the references"), or any combination thereof.

Dependent claims 17 and 102 are independently patentable because they further recite that entity may self-select the manner of benefits listing display. This is entirely foreign to the references.

Dependent claims 18-19 and 103-104 are independently patentable because the storage of part or all of the search results within the system is entirely foreign to the references.

Dependent claims 20-21 and 105-106 are independently patentable because the storage of part or all of the search results outside the system is entirely foreign to the references.

Dependent claims 22-24 and 107-109 are independently patentable because Baker (C10 L59-67, C11 L1-15) does not teach what Examiner (OA #15) believes that it does. Specifically, L59-60 discloses, “. . . *process is performed on a periodic basis to inform consumers . . .*” and (L63) “. . . *daily, weekly, or monthly.*” Showing that this “updating” aspect of Baker is therefore *time-interval-based*. The present invention discloses, on the other hand; automated, entity changed(ing)-status, *event-based* updating, as seen in paragraph 4, page 15 of the present invention’s specification:

“In a preferred embodiment, the system includes means to notify system users, via suitably enabled input/output devices **420**, of any modification or elimination of existing benefits; or the availability of any new benefits; or the pending modification or elimination of existing benefits; or pending availability of new benefits. In this way users **430** will be constantly kept up to date on the benefit(s) or benefit class(es) most important to them.”

And this from its *Example* (paragraph 1, page 18 of specification) :

“Optionally, Dawn may request real time updates of the benefit information via such means as e-mail, FAX, pager, hard-line or web-enabled phone, PDA (Personal Digital Assistants such as the Palm®), etc.



Then, the benefit information applicable to her will be automatically updated as the information gathered from the benefit providers is updated." [Emphasis supplied.]

The distinction is an important one. With Baker (unless one run updates constantly, 24 hours a day, 7 days a week); and especially so since so very many benefits are time-sensitive; who knows what's available to who for how long and under what conditions, concerning one's benefits at any given time? With this valuable feature enabled in the present invention, one always knows (and *without having to run updates*). This system superiority is clearly entirely foreign to Baker and College Board, or any combination thereof.

C10 L64-67 through C11 L1-7 of Baker merely discloses that a consumer may interact either directly or indirectly with the system; while C11 L8-15 merely discloses that the system's benefit information and *time-interval based* updates may be provided or made available to a consumer via any suitable format/delivery means, e.g. postal mail, e-mail, computer bulletin board, etc.

Dependent claims 26 and 111 are independently patentable because displaying a message which does not specify at least one benefit provider is entirely foreign to the references. Not specifying one or more benefit providers means withholding their identification from the entity which would otherwise normally be disclosed to the entity in the benefit display. Such anonymity at this initial disclosure stage (will) provide(s) an important system advantage to at least some of the benefit providers desiring to withhold their identity until a later stage of the benefit delivery process. College Board and Baker teach nothing about providing such benefit-provider privacy.

Dependent claims 27 and 112 are independently patentable because displaying a message which does not specify at least one benefit is entirely foreign to the references. In a similar manner as #54 above; withholding one or more benefits until a later stage of the process will prove to be of great value to some of the benefit providers.

Dependent claims 30 and 115 are independently patentable because, while web-commerce (internet payment systems) were well known by the time invention was made, never before have the income-generation methods disclosed in new claims 30 and 115 ever existed. Now--for the first time ever--a benefit-matching system doesn't have to be advertisement-based or fee-based (or rely on tax dollars like the GovBenefits service does, or on contributions, as the Benefits Check Up service does [recently adding other income-generating systems to their service]). Instead, *the benefits themselves* can supply the revenue needs of the system; freeing the system/company from investing what often proves to be large—sometimes crippling—expenditures in time, effort, and money to build an advertising-supported system. Just as difficult is trying to get people and other entities to pay for the use of such a system before they see if the benefit information/benefits they receive even make it worth the cost. As has been amply and repeatedly reported in the media since the dawn of web-based payment systems, precious few web-based companies have been able to make the subscription model work. Most companies trying to use subscriptions quickly lose up to millions of dollars, find themselves drowning in debt, and go out of business.

Basically, with this teaching, the system can be set up as a “pay-only-for-results” system/method. If a person/entity actually qualifies for and is able to obtain one or more benefits, they share some portion of what they receive with the system operator (or some other entity); if not, the system-using entity has incurred no costs of any type for using the system. Most people love paying only for results when such an option is made available to them. Such new, valuable, and unexpected results are clearly superior to what has existed before.

Additionally, applicant submits that the specific recitations of various payment/income options for the invention within the specification does in fact provide the necessary and required support for new claims 30 & 115: “FIG. 3 is a flow chart . . . Further, central controller 200 charges user’s credit or debit card and updates billing information in the user information database 200 to reflect the “purchase” (transmission) of requested benefit information. It is to be understood that numerous other alternative charging/billing and income-generation methods may be used without detracting from the scope of the present invention . . . per benefit received, a percentage of benefit(s) utilized . . . per benefit viewed, per benefit utilized basis, . . .” from page 13/Detailed Description of the Invention.

While it’s true that the present system would work regardless of how the entity paid for system access and use; as *dependent* claims, an exciting new and improved set of payment/income methods could be used to produce valuable new and unexpected results (including no subscription fees for entity use of system, lower system operational costs, and fewer-to-no advertising difficulties). The entities, the benefit providers, and even the system (operator) itself would all benefit.

As can now be seen, the unique and non-obvious payment/income methods of new/rewritten claims 30 and 115 *are* functionally involved in the steps recited; having both functional manifestation and novel relation to the system’s structure and operation and making them patentable over College Board and Baker; and therefore allowable under Section 103. Therefore, In re Gulack and In re Lowry do not apply to new claims 30 and 115. This “pay-only-for-(benefit)results” disclosure is entirely and completely foreign to College Board, Baker, or any combination thereof.

Dependent claims 46 and 131 are independently patentable because the receiving of value directly or via third-party intermediaries from one or more of the benefit providers themselves is completely foreign to the references.

Dependent claim 48 is independently patentable because the updating, modifying, removing, and adding (new) entity data is—because College Board and Baker teach only *individuals*, as stated—entirely foreign to the references.

Dependent claims 49 and 133 are independently patentable because, in the very least, providing a map and directions to the benefit providers is completely foreign to the references.

Dependent claims 50 and 134 are independently patentable because maintaining the anonymity of one or more of the benefit providers which would otherwise be revealed is entirely foreign to the references ~~(and as per #54 above)~~.

Dependent claims 51, 52 and 135, 136 are independently patentable. While it's true that links predate the system; using them to access any required benefit provider application forms can at times be surprisingly problematic. Links are often known to “break;” directing visitors to either no site, the wrong location in often 100+page benefit-provider web sites, or to wrong sites entirely. Also, while most of the 2<sup>nd</sup>/final OA directs itself to College Board and Baker, which reveal the benefit providers; as is made clear in the present invention's specification, many of the system's potential benefit providers may choose to keep their identity hidden from various benefit-seeking entities early in the process. Unlike with links to benefit provider forms found at the providers' own websites; where there is obviously no problem identifying who the providers are; application forms made available instead as part of or subsequent to the benefit search results being revealed are able to maintain—when desired—providers' confidentiality.

Next, note that College Board's EXPAN system, unlike their Scholarship Search system, is a combination online/offline system which is not web based. To use EXPAN requires a personal meeting with a counselor or other school official to complete the requisite questionnaire; or the taking home of a disk to do the same thing.

The information is then either mailed in or transmitted—apparently over phone lines to a BBS--via the use of proprietary software. Trying to use such a system to obtain timely help in completing sometimes very complicated benefit application forms would be unwieldy in the least; near impossible in the worst.

Therefore, the result of the present system's superior ability to more quickly and easily—and, when needed/desired—*privately and confidentially*--provide the actual application forms and assistance in completing them produces new, valuable, exciting, and unexpected results.

Thus applicant submits that this important and valuable system option is much more than merely a combination of College Board and/or EXPAN with links; and that--under 35 USC 103—the distinguishing matter of claims 51, 52, 135, and 136 are also entirely foreign to College Board, Baker, or any combination thereof.

Dependent claims 54 and 138 are independently patentable because they recite a deeper, more comprehensive (and much more valuable) involvement between the entities and the benefit providers once the benefits applicable to the entities have been identified by the system. College Board and Baker teach only the (limited, as stated) *identification* of benefits (for individuals). Yet, once the benefits have been identified, what next? Should the entity call, or visit, or mail the providers? Who should they ask for? What department? Which office/location? How does one get the forms? Can someone help complete them? How does one receive the benefits? By mail? Fax? Personal visit? Claims 54 and 138 make all these logistical difficulties simple. The references teach none of this novel, unobvious ability. Only the present invention.

Dependent claims 55 and 139 are a fortiori independently patentable because claims 54 and 138 are, as stated, novel and unobvious.

Dependent claims 58 and 142 are independently patentable because the sharing of the benefits information with another via said system and an internet is entirely foreign to the references.

Dependent claims 59 and 143 are independently patentable because the sharing of the benefits with another via said system and an internet is entirely foreign to the references.

Dependent claims 60 and 144 are independently patentable because the availability of benefits which have no acquisition, utilization, or eligibility requirements is completely foreign to the references. Only the present invention—with these two claims—is able to make available valuable benefits *without* having to qualify for them. This is an important teaching College Board and Baker say nothing about; all of their benefits requiring various qualification/membership parameters.

Dependent claims 61 and 145 are independently patentable because obtaining, displaying, accepting, providing, and utilizing at least one of the *no-qualifying-needed* benefits is completely foreign to the references; as with claims 60 and 144.

Dependent claims 62 and 146 are independently patentable because they teach an even more encompassing disclosure of benefits to an entity. By displaying “may, may not, does and does not qualify for benefits,” an entity can discover additional benefits which entity could—by, for example, adjusting its preferences—qualify to obtain which they otherwise wouldn’t even know about. It’s a way to see what benefits a given entity is or may be *close to being qualified* to receive. This obviously valuable and important benefit-identification and acquisition option is completely foreign to the references or any combination of them.

Dependent claims 64 and 148 are independently patentable because the availability of benefits without regards to an entity’s data set; and whether or not entity qualifies for or is eligible for any benefits is completely foreign to the references.

This ability allows an entity to discover which benefits are available via the system; which would, for example, help entity to decide whether or not to use the system (especially valuable where the entity must pay in order to use the system). Only the present invention—with these two claims—allows a benefit-seeking entity to have a “sneak peek” at “all” the benefits available via the system. This is an important teaching College Board and Baker say nothing about; the benefits displayed being only those for which an individual is (or appears to be) qualified to receive.

Dependent claims 65 and 149 are independently patentable because they recite wherein one or more of said benefit providers may at benefit providers’ option submit said benefit information directly into said system. The ability of benefit providers and the system (operator) to greatly reduce or eliminate human involvement and interaction in, for example; the identification of, gathering of, inputting in (to the system), and managing and updating of the benefits information and/or the benefits is of tremendous cost-saving and operational efficiency value. There being not even a single sentence concerning this novel and unobvious teaching in either reference, such valuable, *produces-new-and-unexpected-results* benefit-provider direct submission is clearly and entirely foreign to College Board, Baker, or any combination thereof.

Dependent claims 66 and 150 are independently patentable because the use of (a) third-party intermediaries is completely foreign to the references or their combination.

Dependent claims 67 and 151 are independently patentable because an entity’s selection of the frequency of system updates concerning at least one benefit and/or one benefit class is entirely foreign to the references or their combination.

Dependent claims 73 and 157 are independently patentable because delivering one or more of the benefits themselves (certificates, coupons, monetary equivalents, etc) via an internet is (by making obtaining applicable benefits more quickly and easily) an obviously valuable feature which is completely foreign to the references or their combination. College Board and Baker teach nothing about this.

Dependent claims 74 and 158 are independently patentable because utilizing one or more of the benefits themselves via an internet is (by making the using of applicable benefits quicker and easier) an obviously valuable feature which is completely foreign to the references. College Board and Baker teach nothing about this.

Dependent claims 166 and 171 are independently patentable because receiving (creating) benefit information that does not specify one or more benefit providers is entirely foreign to the references. Not specifying one or more benefit providers means withholding their identification from the entity which would otherwise normally be disclosed to the entity in the benefit display(s). Such anonymity at this initial disclosure stage (will) provide(s) an important system advantage to at least some of the benefit providers desiring to withhold their identity until a later stage of the benefit delivery process. College Board and Baker teach nothing about providing such benefit-provider privacy.

Dependent claims 167 and 173 are independently patentable for the same reasons as for claims 166 & 171; above.

Dependent claim 174 is independently patentable because providing a benefit listing without one or more benefit providers being listed is entirely foreign to the references. Not providing one or more benefit providers means withholding their identification from the entity which would otherwise normally be disclosed to the entity in the benefit display(s).



Such anonymity at this initial disclosure stage (will) provide(s) an important system advantage to at least some of the benefit providers desiring to withhold their identity until a later stage of the benefit delivery process. College Board and Baker teach nothing about providing such benefit-provider privacy.

Applicant accordingly submits that the dependent claims are a fortiori patentable and should also be allowed.

### **Conclusion**

As has now been clearly and convincingly demonstrated: #1—The College Board and Baker references cannot be legally or properly combined. #2—Even if the references were able to be combined; which applicant vehemently disputes; the claims still all define patentable and unobvious subject matter over the prior art. The required factual basis or prima facie case of obviousness has in no way been established. #3--Even if such case could be made; which applicant also vehemently disputes; applicant has offered and supplied here a plethora of separate and substantial additional persuasive arguments including an overwhelming collection of objective evidence of the non-obviousness of the present system; including, as stated: substantial new and unexpected results; solution of long-felt but unsolved need; the failure of others; exploding “grass roots” (as opposed to commercial advertising driven) nationwide commercial success; synergism; competitive recognition; multiplicity of steps required; assumed insolubility; new principle of operation; different problem solved; references teach away from the combination; and lack of implementation. Any of these, when taken individually; and glaringly so when taken together as a whole; easily, convincingly; and in fact overwhelmingly demonstrate and proves the non-obviousness of the subject system.

The dependent claims add additional limitations and are themselves therefore a fortiori patentable.

Accordingly, inasmuch as all requirements of the statutes have now been met and complied with, applicant respectfully requests the reversal of all of the rejections.

Very respectfully,



Steve Morsa

POB 1996

Thousand Oaks, CA 91358

(805) 495-5025 Fax: (805) 495-2783

E-mail: [stevemorsa@cs.com](mailto:stevemorsa@cs.com)

**Certificate of Faxing:** I hereby certify that I will Fax this paper to GAU 3629 of the U.S. Patent and Trademark Office at 703-872-9306 on the date below:

Date: July 26, 2004 Steve Morsa  
Steve Morsa, Applicant/Appellant

**(9) Appendix**

1. A system for permitting an entity to more effectively make use of a variety of available benefits from a plurality of goods, services, information, and value benefit providers, wherein said benefits are offered specifically to those entities qualified/eligible to receive said benefits, said system comprising:

- means for storing in a memory in the system entity information, benefit-provider information, and benefit correlation information;
- means for inputting into said system a set of entity demographic, geographic, psychographic, and preference data for said entity;
- means for inputting into said system benefit information from two or more distinctly different benefit classes/categories;
- means for comparing said entity data set to determine those benefit-providers, if any, which have benefits said entity is qualified to utilize;
- means for analyzing said benefit-provider information and said benefit correlation information to determine whether any benefit-providers are offering potentially applicable benefits for said data and whether said data satisfies requirements for obtaining said potentially applicable benefits;
- means for displaying a message to inform a system user of any available benefits applicable to said data;
- wherein said variety of benefits includes at least one of a discounted rate or value available to the entity as a result of entity's qualifying or being eligible for at least one benefit available from at least one benefit provider;
- wherein said system is unlimited in the number of distinctly different benefit classes/categories it may offer said entity.

16. The system of claim 1, further comprising means for displaying a plurality of available benefits applicable to said data, said plurality of available benefits listed in a manner selected from the group consisting of benefit class or category, value of benefits, cost if any of benefits, importance of benefits, relevance of benefits, ease of use of benefits, expiration date of benefits, creation date of benefits, type of benefits, and physical proximity of said entity to one or more said benefit providers.

17. The system of claim 16, further comprising means for said entity to self-select said manner of benefits listing display.

18. The system of claim 1, further comprising means for the storage within said system of said entity's benefit-search results for entity's future viewing and use.

19. The system of claim 18, further comprising means for the storage within said system of some portion of said entity's benefit-search results.

20. The system of claim 1, further comprising means for the storage outside of said system of said entity's benefit-search results for entity's future viewing and use.

21. The system of claim 20, further comprising means for the storage outside of said system of some portion of said entity's benefit-search results.

22. The system of claim 1, further comprising means for the notification of said entity upon the modification to, update of, change to, elimination of, or the creation of one or more benefits offered by one or more benefit providers.

23. The system of claim 1, further comprising means for the notification of said entity upon the impending modification to, update of, change to, elimination of, or the creation of one or more benefits by one or more benefit providers.

24. The system of claim 1, further comprising means for the notification of said entity of one or more benefits said entity previously did not qualify to receive but for which said entity now does qualify to receive.

26. The system of claim 1, wherein said means for displaying a message that further does not specify at least one benefit provider.

27. The system of claim 1, wherein said means for displaying a message that further does not specify at least one benefit.

29. The system of claim 1, further comprising means of requiring said entity to update said entity data as a condition of said entity continuing to remain a system user.

30. The system of claim 1, further comprising means for said entity and/or said benefit provider to pay for said system access and use via one or more methods from the group of:

on a per benefit disclosed basis; on a per benefit received basis; on a per benefit utilized basis; through said entity's relinquishment of at least a portion of at least one of said benefits; through the payment of some percentage of at least one of said benefits; through the payment from a plurality of at least part of a value equivalent of at least one of said benefits.

46. The system of claim 1, wherein said system further comprises means for the receiving directly or via third party intermediaries of monetary revenue or other value from at least one from the benefit provider group of:

- governments; and
- educational institutions; and
- commercial enterprises; and
- individuals; and
- non-profits and charities.

47. The system of claim 1, further comprising means for:

- updating benefits data; and
- modifying benefits data; and
- removing benefits data; and
- adding new benefits data.

48. The system of claim 1, further comprising means for:

- updating entity data; and
- modifying entity data; and
- removing entity data; and
- adding new entity data.

49. The system of claim 1, further comprising means for:

- providing the physical address of the benefit providers; and
- providing benefit providers' contact information; and
- providing a map for and directions to the benefit providers.

50. The system of claim 1, wherein the name, address, phone number and other contact information of one or more of said benefit providers is not revealed to said entity.

51. The system of claim 1, wherein said means for displaying said benefits includes means for displaying any benefit provider required benefit application forms.

52. The system of claim 51, further comprising means for assisting said entity in the completion of said application forms.

54. The system of claim 1, further comprising:

without leaving system, means for connecting said entity with at least one of said plurality of benefit providers directly via said system; and means for said entity to interact with said benefit providers via said system; and

means for said benefit providers to offer said benefits to said entity via said system; and

means for completion of said application forms, when applicable, by said entity via said system; and

means for transmitting said benefit approval for said entity by said benefit providers via said system; and

means for transmitting an acceptance of said benefits by said entity via said system; and

means for receiving said benefits by said entity via system; and

means for using said benefits by said entity via system.

55. The system of claim 54, further comprising means for performing said direct via system process in real time.

58. The system of claim 1, wherein said entity benefits information is shared with at least one other entity via :

said system; and

an internet

59. The system of claim 1, wherein said entity benefits are shared with at least one other entity via:

- said system; and
- an internet.

60. The system of claim 1, wherein said benefits have no acquisition or utilization qualifications; nor eligibility requirements.

61. The system of claim 60, further comprising:

- means for obtaining at least one of said benefits; and
- means for displaying at least one of said benefits; and
- means for accepting at least one of said benefits; and
- means for providing at least one of said benefits; and
- means for utilization of at least one of said benefits.

62. The system of claim 1, wherein said message display includes means for displaying benefits for which said entity:

- may qualify for one or more benefits; and
- may not qualify for one or more benefits; and
- does qualify for one or more benefits; and
- does not qualify for one or more benefits.

64. The system of claim 1, wherein said entity may at entity's option have said message display inform entity of at least one benefit contained within said memory without regards to:

- said set of entity data; and
- whether or not entity qualifies for or is eligible for any such said benefits.



65. The system of claim 1, wherein one or more of said benefit providers may at benefit provider's option submit said benefit information directly into said system.

66. The system of claim 65, wherein said benefit information is delivered directly into said system via at least one third party intermediary acting on behalf of at least one of said benefit providers.

67. The system of claim 1, wherein said entity selects frequency of said system updates regarding said entity's benefit information concerning:

- at least one benefit; and
- at least one class of benefits.

68. The system of claim 1, wherein the number of said displayed applicable benefits varies according to:

- the amount of said entity data; and
- the data fields said entity fills in; and
- the completeness of said entity data.

69. The system of claim 1, wherein said entity may at entity's option input a complete set of phantom data; wherein said phantom data does not belong to nor correspond to said entity's actual factual data.

70. The system of claim 1, wherein said entity may at entity's option input a partial set of phantom data; wherein said partial set of phantom data does not belong to nor correspond to said entity's actual factual data; said phantom data being inputted together and concurrently with some partial set of actual factual data of said entity.

71. The system of claim 1, wherein said system is operated via an internet.

72. The system of claim 1, wherein said benefit information is delivered via an internet.

73. The system of claim 1, wherein one or more benefits are delivered via an internet.

74. The system of claim 1, wherein one or more benefits are utilized via an internet.

80. A system comprising:

a memory device having embodied therein information relating to a plurality of benefits from at least two distinctly different benefit classes/categories;

a processor in communication with said memory device, said processor configured to:

create a benefits listing for a specified entity with a specified set of demographic,

geographic, psychographic, and preference data;

make available said benefits listing;

examine a plurality of benefits that are available to a plurality of entities, said

listing to determine which of said plurality of benefits to select for said

entity, at least one of said plurality of benefits having qualification

parameters;

select at least one of said plurality benefits; and

provide notification of benefit information to said entity, including the benefit

providers corresponding to said selected benefits.

**81. A system comprising:**

a memory device having embodied therein information relating to a plurality of benefits from at least two distinctly different benefit classes/categories;

a processor in communication with said memory device, said processor configured to:

receive a benefits listing for a specified entity with a specified set of demographic,

geographic, psychographic, and preference data;

provide said benefits listing to an entity;

receive an acceptance of said benefits listing from said entity;

transmit said acceptance to a benefit information provider; and

receive benefit information selected by said benefit information provider,

including the benefit providers corresponding to said selected benefits.

---

**82. A system comprising:**

a memory device having embodied therein information relating to a plurality of benefits from at least two distinctly different benefit classes/categories;

a processor in communication with said memory device, said processor configured to:

receive an acceptance of a benefits listing for a specified entity with a specified

set of demographic, geographic, psychographic, and preference data;

examine a plurality of benefits that would satisfy the specified data set to

determine which of said plurality of benefits to select for said specified

entity;

select at least one of said plurality of benefits; and

provide notice of said selected benefits, wherein said selected benefits include the

benefit providers corresponding to said selected benefits.

83. The system of claim 1, further comprising means for inputting into said system said entity data which also includes entity identification information.

84. The system of claim 1, further comprising means for comparing said entity data set which also includes entity identification information.

85. The system of claim 1, further comprising means for analyzing said entity data which data also includes entity identification information.

86. The system of claim 1, further comprising means for said displaying of a message wherein said entity data also contains entity identification information.

87. In a system, a method for permitting an entity to more effectively make use of a variety of available benefits from a plurality of goods, services, information, and value benefit providers, wherein said benefits are offered specifically to those entities meeting the qualifications/eligibility requirements of one or more benefit providers, said method comprising:

- storing in a memory in the system entity information, benefit provider information, and benefit correlation information;
- inputting a set of entity demographic, geographic, psychographic, and preference data for said entity into said computer system by means of a data entry device electronically communicating with said system;
- inputting into said system benefit information from two or more distinctly different benefit classes/categories;
- operating the computer system to compare said entity data information to determine those benefit providers, if any, which have benefits entity is qualified to utilize;
- further operating said system to determine whether any benefit provider is offering a benefit applicable to said data;
- displaying a message to inform a system user of any available benefits applicable to said data;
- wherein said variety of benefits includes at least one of a discounted rate or any other value available to entity as a result of entity's qualifying for/being eligible for at least one benefit from at least one benefit provider;
- wherein said system is unlimited in the number of distinctly different benefit classes/categories it may offer.

101. The method of claim 87, further comprising the step of displaying a plurality of available benefits applicable to said data, said display listing benefits in a manner selected from the group consisting of benefit class or category, value of benefits, cost if any of benefits, importance or benefits, relevance or benefits, ease of use of benefits, expiration date of benefits, creation date of benefits, type of benefits, and physical proximity of said entity to one or more of said benefit providers.

102. The method of claim 101, further comprising the step of entity self-selecting said manner of displaying said benefits.

103. The method of claim 87, further comprising the step of storing said entity's benefit-search results within said system for said entity's future viewing and use.

104. The method of claim 103, further comprising the step of storing within said system of some portion of said entity's benefit-search results.

105. The method of claim 87, further comprising the step of storing outside of said system of said entity's benefit-search results for said entity's future viewing and use.

106. The method of claim 105, further comprising the step of storing outside of said system of some portion of said entity's benefit-search results.

107. The method of claim 87, further comprising the step of notifying said entity upon the modification to-, update of-, change to-, elimination of-, or the creation of- one or more benefits offered by one or more of said benefit providers.

108. The method of claim 87, further comprising the step of notifying said entity upon the impending modification to-, update of-, change to-, elimination of-, or the creation of- one or more benefits offered by one or more of said benefit providers.

109. The method of claim 87, further comprising the step of notifying said entity of one or more benefits said entity previously did not qualify to receive but for which said entity now does qualify to receive.

111. The method of claim 87, wherein said displaying a message does not specify at least one benefit provider.

112. The method of claim 87, wherein said displaying a message does not specify at least one benefit.

114. The method of claim 87, further comprising the step of requiring said entity to update said entity data as a condition of said entity continuing to remain a system user.

115. The method of claim 87, further comprising the step of said entity's and/or said benefit provider's paying for said system access and use via one or more methods from the group of:

on a per benefit disclosed basis; on a per benefit received basis; on a per benefit utilized basis; through said entity's relinquishment of at least a portion of at least one of said benefits; through said entity's payment of some percentage of at least one of the said benefits; through said entity's payment from at least part of a value from a plurality of value equivalents corresponding to at least one of said benefits.

131. The method of claim 87, further comprising the step of receiving directly or via third party intermediaries monetary revenue or other value from at least one from the benefit provider group of:

- governments; and
- educational institutions; and
- commercial enterprises; and
- individuals; and
- non-profits and charities.

132. The method of claim 87, further comprising the steps of:

- updating benefits data; and
- modifying benefits data; and
- removing benefits data; and
- adding new benefits data.

133. The method of claim 87, further comprising the steps of:

- providing the physical address of the benefit providers; and
- providing benefit providers' contact information; and
- providing a map for and directions to the benefit providers.

134. The method of claim 87, further comprising the step of not revealing to said entity the name and/or address and/or phone number and/or other contact information of one or more of said benefit providers.

135. The method of claim 87, further comprising the step of displaying any benefit provider required benefit application forms when displaying said benefits.

136. The method of claim 135, further comprising the step of assisting said entity in completing said application forms.

138. The method of claim 87, further comprising the step, without leaving said system, of connecting said entity with at least one of said plurality of benefit providers via said system; and

comprising the step of said entity interacting with said benefit providers via said system; and

comprising the step of said benefit providers offering said benefits to said entity via said system; and

comprising the step of completing said application forms, when applicable, by said entity via said system; and

comprising the step of transmitting said benefit approval for said entity by said benefit providers via said system; and

comprising the step of receiving said benefits by said entity via system.

139. The method of claim 138, further comprising the step of performing said direct via system in real time.

142. The method of claim 87, further comprising the step of sharing said entity benefits information with at least one other entity via:

said system; and

an internet.

143. The method of claim 87, further comprising the step of sharing said entity benefits with at least one other entity via:

said system; and

an internet.

144. The method of claim 87, further comprising providing benefit information for benefits which have no acquisition or utilization qualifications/eligibility requirements.



145. The method of claim 144, further comprising the steps of:

- obtaining at least one of said benefits; and
- displaying at least one of said benefits; and
- accepting at least one of said benefits; and
- providing at least one of said benefits; and
- utilizing at least one of said benefits.

146. The method of claim 87, further comprising the step, within said message display, of displaying benefits for which said entity:

- may qualify for one or more benefits; and
- may not qualify for one or more benefits; and
- does qualify for one or more benefits; and
- does not qualify for one or more benefits.

148. The method of claim 87, further comprising the step of entity, at entity's option, displaying within said message display at least one benefit contained within said memory without regards to:

- said set of entity data; and
- whether or not entity qualifies for or is eligible for any such benefits.

149. The method of claim 87, further comprising the step, at said benefit providers' option, of submitting said benefit information directly into said system.

150. The method of claim 149, further comprising the step of delivering said benefit information directly into said system via at least one third party intermediary acting on behalf of at least one of said benefit providers.

151. The method of claim 87, further comprising the step of selecting the frequency of said system updates regarding said entity's benefit information concerning:

- at least one benefit; and
- at least one class of benefits.

152. The method of claim 87, further comprising the step of said displaying applicable benefits wherein the number of displayed benefits varies according to:

- the amount of said entity data; and
- the data fields said entity fills in; and
- the completeness of said entity data.

153. The method of claim 87, further comprising the step, at said entity's option, of inputting a complete set of phantom data; wherein said phantom data does not belong to nor correspond to said entity's actual factual data.

154. The method of claim 87, further comprising the step, at said entity's option, of inputting a partial set of phantom data; wherein said partial set of phantom data does not belong to nor correspond to said entity's actual factual data; said phantom data being inputted together and concurrently with some partial set of actual factual data of said entity.

155. The method of claim 87, further comprising the step of operating said system via an internet.

156. The method of claim 87, further comprising the step of delivering said benefit information via an internet.

157. The method of claim 87, further comprising the step of delivering one or more of said benefits via an internet.

158. The method of claim 87, further comprising the step of utilizing one or more of said benefits via an internet.

164. A method comprising the steps of:

- receiving a request for benefit information;
- querying, using a computer, a central benefit information storage system containing at least two distinctly different benefit classes/categories to determine if any benefits exist for benefit information requester;
- receiving, using a computer, said benefit information;
- accepting at least one of said available benefits.

166. The method of claim 164, wherein said receiving benefit information includes receiving benefit information that further does not specify one or more benefit providers.

167. The method of claim 166, further comprising the steps of:

- transmitting a request of said benefit information; and
- receiving an acceptance of said benefit information.

168. The method of claim 164, wherein said receiving a request includes receiving a request that further contains at least partially inaccurate, “phantom” information concerning benefit seeker.

**169.** A method of using a computer to process a benefit information request, comprising the steps of:

- creating a benefit listing containing at least two distinctly different benefit classes/categories;
- outputting said benefit listing via an electronic system;
- examining a plurality of benefits which would fulfill the benefit information request relating to said benefit listing to determine which, if any, of said plurality of benefits to select for said benefit listing;
- selecting, when available, at least one of said plurality of benefits;
- outputting notification of benefit information corresponding to said selected benefits; and
- accepting at least one of said benefits.

**171.** The method of claim 169, wherein said creating a benefit listing includes creating a benefit listing that further does not specify at least one benefit provider.

**173.** The method of claim 169, further comprising the steps of:  
receiving a request for said benefit information; and  
transmitting an acceptance of said benefit information.

**174.** The method of claim 169, further comprising the step of providing a benefit listing without one or more of benefit providers being listed.

**175.** The method of claim 169, wherein said step of outputting notification includes the step of providing a benefit information listing with benefit providers being listed.

176. A method comprising the steps of:

viewing, using a computer, benefit information from at least two distinctly  
different benefit classes/categories;  
transmitting, using a computer, a request to obtain at least one benefit  
corresponding to said benefit information;  
receiving a commitment for at least one benefit;  
accepting said commitment for said at least one benefit; and  
receiving said at least one benefit.

177. The method of claim 87, further comprising the step of inputting into said  
system said entity data which also includes entity identification information.

178. The method of claim 87, further comprising the step of comparing said entity  
data which also includes entity identification information.

179. The method of claim 87, further comprising the step of analyzing said entity  
data which data also includes entity identification information.

180. The method of claim 87, further comprising the step of displaying said  
message wherein said entity data also contains entity identification information.

EXHIBIT A  
Page 1 of 4[back](#)[print](#)

## LATEST NEWS

✶ **Expanding Your Benefits Connection, GovBenefits.gov Second Anniversary April 29, 2004**

GovBenefits.gov is expanding your benefits connection! As the two-year anniversary of the award-winning GovBenefits.gov website is celebrated, we are pleased to announce that the site is expanding to better serve you. The new GovBenefits.gov includes Spanish-language content with the debut of GovBenefits.gov En Español and additional State program information. The new GovBenefits.gov site was redesigned to make it easier for you to find the government benefit and assistance programs that meet your specific needs. In addition to all citizen-focused Federal benefit programs, GovBenefits.gov contains benefit program information from all 50 U.S. States, helping citizens across the country save time and avoid the hassle of trying to figure out which government agency to contact for assistance.

The expansion of GovBenefits.gov increases the ability of the site to help citizens learn more about the government benefit and assistance programs that may be available to them. GovBenefits.gov En Español offers Spanish-speaking communities even greater access to Federal and State benefit programs, while the expanded State benefit information gives citizens additional avenues to locate State-level assistance programs.

Since its launch in April 2002, GovBenefits.gov has provided more than 10 million visitors with information on government benefit and assistance programs, and generated nearly 1.7 million citizen referrals to benefit programs. GovBenefits.gov contains information on more than 500 Federal and State benefit and assistance programs.

For information about the GovBenefits.gov Second Anniversary Event, please contact us via email at [GovBenefitsMedia@dol.gov](mailto:GovBenefitsMedia@dol.gov).

App. No. 09/832,440/MUSA

EXHIBIT A  
Page 2 of 4

back

print

**PRESS RELEASE**

• Nov 13, 2003

**GovBenefits.gov Adds New State Programs and Redesigns Homepage; Site Now Includes Information on 48 State and 419 Federal Programs**

WASHINGTON -The U.S. Department of Labor, in conjunction with the Office of Management and Budget, today announced the launch of a new version of GovBenefits.gov, a Web site developed to serve citizens as the first government-wide resource for citizen benefit information and eligibility screening. In addition to all citizen-focused federal benefit programs, this new version of GovBenefits.gov also includes state benefit programs from: Alabama, Arizona, Arkansas, California, Colorado, Georgia, Indiana, Iowa, Kentucky, Michigan, Minnesota, New Mexico, North Carolina, North Dakota, Ohio, Oklahoma, Pennsylvania, South Carolina, South Dakota and Utah. The State benefit program information that can now be found on the site includes: Food Stamps, Medicaid, Temporary Assistance for Needy Families and State Children's Health Insurance Programs. With these enhancements, GovBenefits.gov has taken concrete steps toward providing a single place for both Federal and State benefit program information.

GovBenefits.gov has also undergone important upgrades:

**Homepage Redesign** - Includes new look and feel, and more ways for visitors to obtain Federal and State benefit information.

**More Streamlined Questionnaire** - Results in significantly fewer questions for visitors to answer and allows visitors to stop at any time while completing questionnaire and see what benefits are available up to that point.

**Greater Access** - Provides additional ease of use for those who employ screen readers or other assistive devices.

**GovBenefits.gov Survey** - Helps measure customer satisfaction and guide future improvements.

To view all of these the new site features, visit: <http://www.govbenefits.gov/>.

"GovBenefits.gov is dedicated to making government benefit information easier for citizens to obtain" said Patrick Pizzella, Assistant Secretary for Administration and Management and Chief Information Officer at the Department of Labor. "One important way the site has done that is by exploring the previously uncharted territory of providing a single place for both Federal and State benefit program information."

GovBenefits.gov is one of 24 key initiatives that comprise the President's E-Government Strategy, an integral part of President Bush's Management Agenda, which focuses on: creating a more accessible government, saving taxpayer dollars, and streamlining citizen-to-government transactions. GovBenefits.gov is the collaborative effort of 10 federal agencies including: Departments of Labor (managing partner), Agriculture, Education, Energy, Health and Human Services, Housing and Urban Development, State, Veterans Affairs, Homeland Security, and the Social Security Administration.

App. No. 09/832,440/MORSA



## The National Council on the Aging

Press Room: News Archive

### BenefitsCheckUp® Tops One Million Mark September 16, 2003

**WASHINGTON, DC** -- Since its national launch in June 2001, BenefitsCheckUp - the first Web-based service designed to help older Americans, their families, caregivers and community organizations determine quickly and easily what programs and benefits seniors may qualify for and how to claim them - has issued more than one million eligibility reports.

"This is a significant milestone, but we have a long way to go" said NCOA President James Firman. NCOA and its partners, including America Online's corporate investment department that hosts BenefitsCheckUp on a pro bono basis, anticipate that five million will use the service over the next four years.

More than 100,000 seniors have found significant prescription savings using BenefitsCheckUpRx, a new feature added in February that allows you to search only for savings programs related to medications.

BenefitsCheckUp is a free and confidential service which can be accessed through the Internet at [www.benefitscheckup.org](http://www.benefitscheckup.org). When visiting the site, users complete a brief questionnaire which generates a personalized report specifying a list of programs they may be eligible for and detailed instructions on how to enroll.

Among the programs included are those that help seniors find income support, prescription drug savings, government health programs, energy assistance, property tax relief, nutrition programs, in-home services, Veteran's programs as well as volunteer, educational and training programs.

Of all persons screened thus far, some 26 percent were eligible for, but not receiving food stamps, and 17 percent were eligible for, but not receiving Medicaid. Almost 40 percent were eligible for Weatherization benefits.

A national mobilization effort to expand the reach of the site now involves hundreds of organizations and provides outreach to low-income seniors. There are currently grassroots programs in Baltimore, Chicago, Cleveland, Dallas, Denver, Philadelphia, and the state of Washington. In addition, the new and improved BenefitsCheckUp® Organizational Edition is now available on an annual subscription basis to organizations that can use it to reach out into communities to help even more seniors.

NCOA and its national outreach partners such as AARP, Catholic Charities, USA, Lutheran Services in America, The Salvation Army, Volunteers of America, United Jewish Communities, Jewish Family and Children's Services, Alliance for Children and Families, and the American Association of Homes and Services for the Aging are mobilizing more than 2,000 community organizations across the country to find and help isolated seniors who could benefit from the service. A Spanish language version of BenefitsCheckUp for use by community organizations will be available in the fall of 2003.

BenefitsCheckUp® is supported by the following: AARP, AOL Time Warner Foundation, Archstone Foundation, FJC - A Foundation of Donor Advised Funds, Lucent Technologies Family Care Development Fund, Pfizer, Pharmaceutical Research and Manufacturers of America (PhRMA), TogetherRX, and the U.S. Department of Commerce. They make BenefitsCheckUp® available as a free service to the public. The Web site is hosted by AOL's GovernmentGuide.com.

The Organizational Edition and the community outreach effort are funded by Atlantic Philanthropies, the U.S. Department of Commerce, and The Commonwealth Fund.

App No. 09/832,440/MASA



EXHIBIT A; page 4 of 4

*Founded in 1950, The National Council on the Aging is the nation's first organization dedicated to promoting the dignity, independence, well-being, and contributions of older Americans. NCOA serves as a national voice and powerful advocate on behalf of older Americans. NCOA is an innovator, developing programs such as BenefitsCheckUp, Foster Grandparents and Family Friends. NCOA is an activator, working with its thousands of community organization members nationwide to provide needed services to older people. For more information on NCOA, visit [www.ncoa.org](http://www.ncoa.org).*

# # #

[<< Return to News Archive Main](#)

[Print](#)

[Go back to previous page](#)

Copyright © 2004 National Council on the Aging. All Rights Reserved.

App No. CA/832, 440/MOSA